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**THIS DISPOSITION
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Paper No. 17
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bacou USA Safety, Inc.¹

Serial No. 75/308,169

Elliot A. Salter of Salter & Michaelson for applicant.

Susan R. Stiglitz, Trademark Examining Attorney, Law
Office 103 (Michael A. Szoke, Managing Attorney).

Before Hohein, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

A trademark application has been filed to register
the mark BANDIT for "safety eyewear, namely, spectacles,
frames and lens therefor."²

The examining attorney has finally refused
registration under Section 2(d) of the Trademark Act, 15

¹ Bacou USA Safety, Inc. is the current owner of record of this
application, by assignment recorded in the USPTO from the original
applicant, Uvex Safety, Inc.

² Serial No. 75/308,169, in International Class 9, filed June 13, 1997,
based on an allegation of a bona fide intention to use the mark in
commerce. Applicant filed an amendment to allege use and specimens on
March 16, 1998, alleging first use and first use in commerce as of
November 17, 1997.

U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark BAND-IT, previously registered for "eyeglass retaining band,"³ that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

We address, as a preliminary matter, applicant's principal contention against the refusal in this case "that the PTO should be estopped from refusing to register Applicant's mark as likely to cause confusion with cited Reg. # 1,518,775 because such a position is completely inconsistent with a past decision of the PTO involving essentially the same marks and the same facts." [Applicant's reply brief, p. 3.] Applicant explains that the USPTO allowed for publication a third-party prior pending application, referenced in the examining attorney's first office action, Serial No. 74/725,956, for the mark BANDITOS for "safety glasses, safety goggles

³ Registration No. 1,518,775 issued January 3, 1989, for a period of 20 years, in International Class 9. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.] The current owner of record in the USPTO is Outlook Eyewear Company Corporation.

and impact resistant spectacles." Applicant states as follows:

Applicant had come to the conclusion that since the term BANDITOS appeared to be the pluralized Italian translation of the term BANDIT, although not technically so, and since the goods in the BANDITOS application were basically the same as those of Applicant. Applicant logically assumed that if it could acquire or remove the BANDITOS application, Applicant's application would then successfully go forward for the same reasons that the BANDITOS application had gone to publication and been allowed.

Applicant further states that, to avoid having the BANDITOS application as an obstacle to registration herein, applicant concluded an agreement with the owner of the BANDITOS application to abandon the BANDITOS application, and that application has been abandoned. Applicant argues that "[u]nder the doctrine of *Stare Decisis*, the PTO should be required to stand by the precedent it set when it allowed the BANDITOS application over the then existing Reg. No. 1,518,775 for the mark BAND-IT for 'eyeglass retaining band.'"

The Board is not estopped from making a finding on the issue of likelihood of confusion in an *ex parte* appeal by the position or arguments of either the examining attorney in this case or of another examining attorney in a third-party pending application. The Board must decide an *ex parte* appeal based only on the facts in

the record of that case. Not only is the record of the alleged BANDITO application not part of the record before us in this case, but, notwithstanding applicant's assertions to the contrary, the BANDITO mark is not the same as or substantially similar to applicant's BANDIT mark, nor are the goods identical.⁴

Turning to the issue on appeal, our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See, In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in

⁴The doctrine of *stare decisis* is inapposite in this case. In an *ex parte* appeal, the Board would not accord a decision of an examining

their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See, Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant admits that "the marks are phonetically equivalent" [applicant's brief, p. 6]; but contends that the connotations are different. Applicant states that BAND-IT, in connection with "eyeglass retaining bands"

attorney on the issue of likelihood of confusion *stare decisis* effect.

connotes "putting a band around one's head" [*id.*], but that, in connection with applicant's mark, BANDIT connotes "a thief or a rogue." We agree with the examining attorney that the marks are phonetically equivalent and similar in appearance. We agree with applicant that the connotations of marks may be distinguished by the hyphen in registrant's mark, such that BAND-IT more likely connotes putting a band on one's eyewear and/or around one's head, whereas BANDIT more likely connotes a thief or rogue. However, we find this factor to be outweighed by the marks' similarities in sound and appearance. We find that the marks, considered in their entireties, have substantially similar overall commercial impressions.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783

(Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The examining attorney has submitted copies of numerous third-party registrations for marks identifying goods including both eyeglasses and spectacles, for both safety and other wear, and retaining bands therefor. Third-party registrations which cover a number of differing goods, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to

the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). We considered as probative in this case only those third-party registrations based on use in commerce.

Based on the record, we find the goods sufficiently related that, if used or registered in connection with confusingly similar marks, confusion as to source is likely. We are not convinced otherwise by applicant's argument that its products are safety wear, whereas the goods in the cited registration are for use in connection with "regular" eyewear. The cited registration is not so limited and must be read to encompass retaining bands for safety eyeglasses as well as for other types of eyeglasses.

With regard to applicant's assertion that it is aware of no instances of actual confusion occurring as a result of the contemporaneous use of applicant's mark and the mark in the cited registration, we note that, while a factor to be considered, the absence or presence of actual confusion is of little probative value where we

have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See, *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465, 1470-1471 (TTAB 1992).

Therefore, we conclude that in view of the substantial similarities in sound, appearance and overall commercial impressions of applicant's mark, BANDIT, and registrant's mark, BAND-IT, their contemporaneous use on the goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

If we had any doubt concerning our conclusion that confusion is likely, we would be obligated to resolve such doubt in favor of the registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988).

Decision: The refusal under Section 2(d) of the Act is affirmed.

G. D. Hohein

Serial No. 75/308,169

C. E. Walters

T. E. Holtzman
Administrative Trademark Judges,
Trademark Trial and Appeal Board